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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/800,112
Filing Date: March 05, 2001
Appellant(s): NASON ET AL.

Nason et al.
For Appellant

Supplemental
EXAMINER'S ANSWER

This is in response to the appeal brief filed June 21, 2006 appealing from the Office action mailed August 24, 2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

US 2001/0026545 A1	Matsumoto et al.	October 4, 2001
US 6,363,065 B1	Thorton et al.	March 26, 2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 22-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (US2001/0026545A1) and in view of Thorton et al. (US006363065B1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. (US2001/0026545A1) and in view of Thorton et al. (US006363065B1).

With regard to claim 22, Matsumoto discloses,

- *generating a message to be exchanged between said IP phone and said PBX;*
(Matsumoto, pg.6, para.58-59)

Matsumoto teaches of a *"PBX 40 and the IP phone device 50 are connected physically through the network-gateway device 30, and thus a signal transmitted from the PBX 40 ... is relayed by the network-gateway device 30, and is received by the IP phone 50"* (Matsumoto, pg.6, para.59).

- *transmitting the encapsulated message.* (Matsumoto, pg.6, para.58-59)

Matsumoto teaches of a *"PBX 40 and the IP phone device 50 are connected physically through the network-gateway device 30, and thus a signal transmitted from the PBX 40 ... is relayed by the network-gateway device 30, and is received by the IP phone 50"* (Matsumoto, pg.6, para.59).

However, Matsumoto does not explicitly disclose,

- *encapsulating said message with a Protocol Header and an IP Message body, wherein the Protocol Header includes an indication of Protocol Type for denoting whether the message is an IP message or an encapsulated non-IP message, a Device Number for denoting by means of MAC (Media Access Control) an address within said PBX to which said message is to be transmitted or from which said message is to be received, and Message Type for identifying the type of message contained in the IP Message Body; and,*

Thorton teaches,

- *encapsulating said message with a Protocol Header and an IP Message body, wherein the Protocol Header includes an indication of Protocol Type for denoting whether the message is an IP message or an encapsulated non-IP message, a Device Number for denoting by means of MAC (Media Access Control) an address within said PBX to which said message is to be transmitted or from which said message is to be received, and Message Type for identifying the type*

of message contained in the IP Message Body; and, (Thorton, col.14, line 35 – col.15, line 7; col.23, lines 5-31)

Thorton teaches *"upon receipt of each of these packets for any one channel, assembles these packets for that channel into proper IP packets with necessary IP headers, including originating and destination IP addresses as well as other required information, and transmits these packets"* (Thorton, col.14, lines 38-43).

Hence, Thorton teaches of encapsulating data into IP packets with the appropriate headers, source and destination addresses, and type. Furthermore, Matsumoto teaches *"the IP phone 50 requests the network-gatekeeper device 60 to register the IP phone 50 in the PBX 40 by transmitting an IP-terminal-location-registration-request message including its extension and its IP address"* (Matsumoto, pg.6, para.61). Hence, Matsumoto implies that there are different types of messages communicating between the PBX and the IP phone according to their *"message type"*. In addition, there is a *"device number"* for each particular IP phone and that *"device number"* is maintained via a mapping in the PBX.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Thorton with the teachings of Matsumoto to enable a *"VOIP structure that warrants widespread adoption and substantial cost savings that could well accrue from its use"* (Thorton, col.4, lines 30-32).

With regard to claims 23-26, Matsumoto and Thorton disclose,

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- *wherein said message is a Device Registration Request, and further comprising transmitting the Device Registration request from said IP Phone to said PBX responsive to one of either a power-up or a resetting of said IP phone.*

(Matsumoto, pg.6, para.61-62, pg.8, para.71; Thorton, col.16, line 60 – col.17, line 28; col.18, lines 39-47; col.42, lines 26-52)

- *further comprising generating, encapsulating and transmitting a Device registration request Acknowledgement message from said PBX to said IP phone.*

(Matsumoto, pg.6, para.61-62, pg.8, para.71; Thorton, col.16, line 60 – col.17, line 28; col.18, lines 39-47; col.42, lines 26-52)

- *further comprising generating, encapsulating and transmitting a Device De-Registration Request message from said IP phone to said PBX.* (Matsumoto, pg.6, para.61-62, pg.8, para.71; Thorton, col.16, line 60 – col.17, line 28; col.18, lines 39-47; col.42, lines 26-52)

- *further comprising generating, encapsulating and transmitting a Device De-Registration Acknowledgement message from said PBX to said IP phone.*

(Matsumoto, pg.6, para.61-62, pg.8, para.71; Thorton, col.16, line 60 – col.17, line 28; col.18, lines 39-47; col.42, lines 26-52)

With regard to claims 27-28, Matsumoto and Thorton disclose,

- *Wherein said message is a Device ICMP Echo (ping) request, and further comprising transmitting the Device ICMP Echo (ping) request from said PBX to said IP Phone for testing for the presence of said IP phone.* (Thorton, col.26, lines 4-55)

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- *Further comprising generating, encapsulating and transmitting a device ICMP Echo (Ping) results message from said IP phone to the PBX. (Thorton, col.26, lines 4-55)*

With regard to claims 29-38, Matsumoto and Thorton disclose,

- *further comprising generating encapsulating and transmitting a device tone generation request message from said PBX to said IP phone responsive to registration of said IP phone with said PBX and said IP phone going off-hook. (Matsumoto, pg.1, para.5, para.10-11, pg.6, para.61-62, pg.8, para.71; Thorton, col.16, line 60 – col.17, line 28; col.18, lines 39-47; col.42, lines 26-52)*
- *further comprising generating encapsulating and transmitting a Remove Tone device generation request message from said PBX to said IP phone. (Matsumoto, pg.1, para.5, para.10-11, pg.6, para.61-62, pg.8, para.71; Thorton, col.16, line 60 – col.17, line 28; col.18, lines 39-47; col.42, lines 26-52)*
- *further comprising generating encapsulating and transmitting an Open Receive Stream Request from said PBX to said IP phone for establishing an audio path from said PBX to said IP phone. (Matsumoto, pg.1, para.5, para.10-11, pg.6, para.61-62, pg.8, para.71; Thorton, col.16, line 60 – col.17, line 28; col.18, lines 39-47; col.42, lines 26-52)*
- *further comprising generating encapsulating and transmitting an Open Receive Stream Acknowledgement from said IP phone to said PBX. (Matsumoto, pg.1, para.5, para.10-11, pg.6, para.61-62, pg.8, para.71; Thorton, col.16, line 60 – col.17, line 28; col.18, lines 39-47; col.42, lines 26-52)*

With regard to claims 39-41, Matsumoto and Thorton disclose,

- *wherein said message is a Device IP address update request message, and further comprising transmitting the Device IP address request from said PBX to said IP phone for initiating update of any change in IP address of said IP phone. (Matsumoto, pg.2, para.15, pg.3, para.22-25)*
- *further comprising generating encapsulating and transmitting a Device IP address update acknowledgement from the IP phone to said PBX. (Matsumoto, pg.2, para.15, pg.3, para.22-25)*
- *wherein said message is a legacy call control message. (Matsumoto, pg.2, para.15, pg.3, para.22-25)*

(10) Response to Argument

With regard to heading I. Legal Standard, the Applicants point out that:

- *To establish a prima facie case of obviousness based on a combination of references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In re Raynes, 7 F.3d 1037, 1039, 28 U.S.P.Q.2D (BNA) 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D (BNA) 1443, 1445 (Fed. Cir. 1992). Obviousness cannot be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991). As discussed in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.*

- *The Patent and Trademark Office has the burden under section 103 to establish a prima facie case of obviousness. In re Piasecki 223 USPQ 2d 785 (Fed. Cir. 1984). They can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to an ordinary skill in the art would lead the individual to combine relevant teachings of the references. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988).*

However, the Examiner cannot find any arguments from the Applicants in the above passages. In the above passages, the Applicants merely stated known decisions from different case laws, but did not present forth any specific arguments regarding the current application.

Nevertheless, the Examiner would like to repeat the 35 U.S.C. 103(a) rejection of independent *claim 22* showing the case of prima facie as taught by Matsumoto et al. (US2001/0026545A1) and in view of Thorton et al. (US006363065B1).

With regard to *claim 22*, Matsumoto discloses,

- *generating a message to be exchanged between said IP phone and said PBX; (Matsumoto, pg.6, para.58-59)*

Matsumoto teaches of a "PBX 40 and the IP phone device 50 are connected physically through the network-gateway device 30, and thus a signal transmitted from the PBX 40 ... is relayed by the network-gateway device 30, and is received by the IP phone 50" (Matsumoto, pg.6, para.59).

- *transmitting the encapsulated message. (Matsumoto, pg.6, para.58-59)*

Matsumoto teaches of a "PBX 40 and the IP phone device 50 are connected physically through the network-gateway device 30, and thus a signal

transmitted from the PBX 40 ... is relayed by the network-gateway device 30, and is received by the IP phone 50" (Matsumoto, pg.6, para.59).

However, Matsumoto does not explicitly disclose,

- *encapsulating said message with a Protocol Header and an IP Message body, wherein the Protocol Header includes an indication of Protocol Type for denoting whether the message is an IP message or an encapsulated non-IP message, a Device Number for denoting by means of MAC (Media Access Control) an address within said PBX to which said message is to be transmitted or from which said message is to be received, and Message Type for identifying the type of message contained in the IP Message Body; and,*

Thorton teaches,

- *encapsulating said message with a Protocol Header and an IP Message body, wherein the Protocol Header includes an indication of Protocol Type for denoting whether the message is an IP message or an encapsulated non-IP message, a Device Number for denoting by means of MAC (Media Access Control) an address within said PBX to which said message is to be transmitted or from which said message is to be received, and Message Type for identifying the type of message contained in the IP Message Body; and,*
(Thorton, col.14, line 35 – col.15, line 7; col.23, lines 5-31)

Thorton teaches "*upon receipt of each of these packets for any one channel, assembles these packets for that channel into proper IP packets with necessary IP headers, including originating and destination IP addresses as well as other required information, and transmits these packets*" (Thorton, col.14, lines 38-43). Hence, Thorton teaches of encapsulating data into IP

packets with the appropriate headers, source and destination addresses, and type. Furthermore, Matsumoto teaches *"the IP phone 50 requests the network-gatekeeper device 60 to register the IP phone 50 in the PBX 40 by transmitting an IP-terminal-location-registration-request message including its extension and its IP address"* (Matsumoto, pg.6, para.61). Hence, Matsumoto implies that there are different types of messages communicating between the PBX and the IP phone according to their *"message type"*. In addition, there is a *"device number"* for each particular IP phone and that *"device number"* is maintained via a mapping in the PBX.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Thorton with the teachings of Matsumoto to enable a *"VOIP structure that warrants widespread adoption and substantial cost savings that could well accrue from its use"* (Thorton, col.4, lines 30-32).

With regard to heading II. Claim 22 Is Not Obvious, the Applicants point out that:

- *Thorton discloses a telephone gateway which, when operated with a similar peer Gateway and each being connected at opposite ends of the Public Switched Telephone Network (PSTN) and IP data network, dynamically switches a call alternately between the data network and the PSTN based on real-time measurements of quality of service associated with the data network. However, while Thorton teaches forming data into IP packets, there is no teaching or suggestion of the use of a Protocol type indicator within a protocol header for encapsulating a message.*

However, the Examiner finds that the Applicants' arguments are not persuasive because Thorton discloses *"upon receipt of each of these packets for any one channel, assembles these packets for that channel into proper IP packets with necessary IP headers, including originating and destination IP addresses as well as other required information, and transmits these packets"* (Thorton, col.14, lines 38-43). Hence, Thorton teaches of encapsulating data into proper IP packets with the appropriate headers, source and destination addresses, and type.

Furthermore, as presented by the Examiner in the Advisory Action dated December 21, 2005, *"it is very well known in the networking art that there is a Protocol field, which specifies the type of the encapsulated protocol, in the IP packet header as defined by the TCP/IP protocol suite."* It is well known in the networking art that the protocol field identifies *"which protocol gave the data for IP to send"* (TCP/IP Illustrated, Volume 1 – The Protocols, W. Richard Stevens, 1994, pages. 34-37, figure 3.1).

In addition, the Applicants also incorrectly noted that not only does *"Thorton teaches forming data into IP packets"* (Appeal Brief, pg.4, para.5); but, in fact, Thorton discloses, *"upon receipt of each of these packets for any one channel, assembles these packets for that channel into proper IP packets with necessary IP headers, including originating and destination IP addresses as well as other required information, and transmits these packets"* (Thorton, col.14, lines 38-43). Hence, Thorton teaches of encapsulating data into proper IP packets with the appropriate headers, source and destination addresses, and type as well known to one of ordinary skill in the art of networking.

With regard to heading II. Claim 22 Is Not Obvious, the Applicants point out that:

- *Nowhere in Thorton can one skilled in the art find any teaching or suggestion for use of a Protocol Header as defined relative to claim 22. Claim 22 requires a Protocol Header that has an indication of Protocol Type for denoting whether the message is an IP message or an encapsulated non-IP message, the Protocol Header encapsulating the message.*

However, the Examiner finds that the Applicants' arguments are not persuasive because "an encapsulated non-IP message" is still "an IP message". Hence, there is no difference between an IP message and an encapsulated non-IP message. Furthermore, according to the Applicants' preamble, that states "a method of communication between an IP phone and a network-implemented PBX comprising", meaning that the messages (i.e., data) from both the IP phone and the network-implemented PBX are already IP messages. Hence, to encapsulate those IP messages into other IP messages is well known in the art of networking as evidence by Thorton, "upon receipt of each of these packets for any one channel, assembles these packets for that channel into proper IP packets with necessary IP headers, including originating and destination IP addresses as well as other required information, and transmits these packets" (Thorton, col.14, lines 38-43).

With regard to heading III. The Rejection Is Based On Speculation, the Applicants point out that:

- *The Examiner rejected the above argument in the Advisory Action, not by reference to any suggestion found in the cited prior art, but by engaging in pure speculation, The examiner opines that it is well known that "there is a Protocol*

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field, which specifies the type of the encapsulated protocol, in the IP packet header”, yet cites no evidence in the prior art supporting this contention. In fact, the cited art specifically has no such disclosure, nor would it be inherent since such Protocol types are not even mentioned.

However, the Examiner finds that the Applicants' arguments are not persuasive because as presented by the Examiner in the Advisory Action dated December 21, 2005, *“it is very well known in the networking art that there is a Protocol field, which specifies the type of the encapsulated protocol, in the IP packet header as defined by the TCP/IP protocol suite.”* It is well known in the networking art that the protocol field identifies *“which protocol gave the data for IP to send”* (TCP/IP Illustrated, Volume 1 – The Protocols, W. Richard Stevens, 1994, pages. 34-37, figure 3.1).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Thomas Duong (AU2145)



September 26, 2006

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